

Notice of Allowability

Application No.

09/326,402

Examiner

Channing S Mahatan

Applicant(s)

BLUMENFELD ET AL.

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 19 December 2003.
2. ☒ The allowed claim(s) is/are 121-137, 140, 141, 150, 165 and 166.
3. ☒ The drawings filed on 04 March 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 2 Sheets
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 04 February 2004.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

APPLICANTS' ARGUMENTS

Applicants' arguments, filed 19 December 2003, have been fully considered and are deemed to be persuasive.

EXTENSION OF TIME

An extension of time under 37 C.F.R. § 1.136(a) is required in order to make an Examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on 04 February 2004, Frank C. Eisenschenk requested an extension of time for 2 MONTH(S) and authorized the Director to charge Deposit Account No. 19-0065 the required fee of \$420.00 for this extension and authorized the following Examiner's amendment. Should the changes and/or additions be unacceptable to Applicants, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

EXAMINER'S AMENDMENT

Authorization for this Examiner's amendment was given in a telephone interview with Frank C. Eisenschenk on 04 February 2004 and 05 February 2004.

Please amend the following claims:

121. (currently amended) A method of genotyping comprising determining the identity of a nucleotide at a biallelic marker of SEQ ID NO: 12, or the complement of said nucleotide, in a biological sample, wherein said biallelic marker is selected from the group consisting of biallelic markers of SEQ ID NO: 12 located at positions 402 (A2), 67092 (A30), 68525 (A41), 82234 (A55), 82393 (A57), and 87713 (A75).

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135. (currently amended) A method of detecting an association between a haplotype and a trait, comprising the steps of:

a) estimating the frequency of at least one haplotype in a trait positive population ~~according to the method of claim 133;~~

b) estimating the frequency of said haplotype in a control population, wherein steps a) and b) are performed according to the method of claim 133;

c) determining whether a statistically significant association exists between said haplotype and said trait, wherein said trait is familial or sporadic prostate cancer.

Please substitute the following paragraph, beginning at page 5, line 26, with the following paragraph:

SEQ ID NO: 12 is a version of the polynucleotide sequence of the PCTA-1 gene of SEQ ID NO: 1 that provides symbols appropriate for indicated allelic substitutions at nucleotide positions 402, 67092, 68525, 82234, and 82393. ~~SEQ ID NO: 12~~

REASONS FOR ALLOWANCE

The following is an Examiner's statement of reasons for allowance:

The filing of the amendments to claims have overcome all grounds of rejection in the Office Action, mailed 21 May 2003, and no other grounds for rejection are present. Therefore, claims 121-137, 140, 141, 150, 165, and 166 are deemed allowable. No pending United States applications have been identified with claims directed to the same invention as claimed herein. Any comments considered necessary by Applicants must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee.

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Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

EXAMINER INFORMATION

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 C.F.R. § 1.6(d)). The CM1 Fax Center number is either (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Channing S. Mahatan whose telephone number is (571) 272-0717. The Examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina M. Plunkett, whose telephone number is (571) 272-0549 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

Date: *February 5, 2004*

Examiner Initials: *CSM*

Marianne P. Allen
MARIANNE P. ALLEN
PRIMARY EXAMINER
AC1631